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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,333	08/09/2001	Thomas Mammone	01.38US	4422

7590 06/11/2003

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EXAMINER

WHITE, EVERETT NMN

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 06/11/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/925,333

Applicant(s)

MAMMONE ET AL.

Examiner

EVERETT WHITE

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

### DETAILED ACTION

1. The amendment filed April 1, 2003 has been received, entered and carefully considered. The amendment affects the instant application accordingly:
  - (A) Comments regarding Office Action have been provided drawn to:
    - (i) 103(a) rejection, which has been maintained for the reasons of record.
2. Claims 1-19 are pending in the case.
3. The text of those sections of title 35, U. S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 103***

4. Claims 1, 2, 5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Denis et al (US Patent No. 5,286,629) for the reasons disclosed on pages 2 and 3 of the Office Action mailed October 1, 2002.
5. Applicant's arguments filed April 1, 2003 have been fully considered but they are not persuasive. Applicants argue against the rejection on the grounds that the phosphosugar disclosed in the Denis et al patent is only used as a ligand to bind the product having therapeutic value to a receptor site on the keratinocytes. Applicants argue that any beneficial effects achieved by the compositions disclosed in the Denis et al patent is achieved by the product to which the ligand is bound, and not by the ligand per se, the sole function of which is to get the product to the proper cell. This argument is not persuasive because the ligand (which may be a phosphosugar) is part of the composition that is used to treat skin. The phosphosugar of the Denis et al as part of the composition that is used to treat skin falls within the scope of being a component of a composition that is applied to the skin as instantly claimed. Applicants are reminded that products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada* 15 USPQ 2d 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The Denis et al patent clearly shows that the use of a

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phosphosugar in a composition that can be used in a regiment to treat damage skin is well known in the art. The fact that Applicants may have found that the composition containing phosphosugar is more effective than anticipated (i.e., can be used to exfoliate skin) is not persuasive of unobviousness where what is claimed would flow naturally from the teachings of the prior art. *In re Adams et al.* (CCPA 1960) 284 F2d 525, 128 USPQ 116; *In re Libby* (CCPA 1958) 255 F2d 412, 118 USPQ 94; *In re Crockett et al.* (CCPA 1960) 279 Fed 274, 126 USPQ 186; *In re Lieser* (CCPA 1947) 162 Fed 224, 74 USPQ 104; *In re Olsen* (CCPA 1944) 146 F2d 501, 64 USPQ 180. Accordingly, the rejection of Claims 1, 2, 5 under 35 U.S.C. 103(a) as being unpatentable over the Denis et al patent is maintained for the reasons of record.

6. Claims 7, 8, 11, 13-15, and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Denis et al (US Patent No. 5,286,629) for the reasons already of record on pages 3 and 4 of the Office Action mailed October 1, 2002.

7. Applicant's arguments filed April 1, 2003 have been fully considered but they are not persuasive. Applicants argue against the rejection on the grounds that the Denis et al patent does not teach or suggest to one of skill in this art that phosphosugars can enhance glycosaminoglycan levels, or that they have any biological activity other than the ability to bind to a receptor on a keratinocyte. This argument is not persuasive for the same reasons argued in the above rejection of the claims. The phosphosugar of the Denis et al patent as part of a composition that is used to treat skin falls within the scope of being a component of a composition that is applied to the skin as instantly claimed. Applicants are reminded that products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada* 15 USPQ 2d 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The Denis et al patent clearly shows that the use of a phosphosugar in a composition that can be used in a regiment to treat damage skin is well known in the art. The fact that Applicants may have found that the composition containing phosphosugar is more effective than

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anticipated is not persuasive of unobviousness where what is claimed would flow naturally from the teachings of the prior art. *In re Adams et al.* (CCPA 1960) 284 F2d 525, 128 USPQ 116; *In re Libby* (CCPA 1958) 255 F2d 412, 118 USPQ 94; *In re Crockett et al.* (CCPA 1960) 279 Fed 274, 126 USPQ 186; *In re Lieser* (CCPA 1947) 162 Fed 224, 74 USPQ 104; *In re Olsen* (CCPA 1944) 146 F2d 501, 64 USPQ 180. Accordingly, the rejection is maintained because the instant claims set forth a method for increasing levels of glycosaminoglycans in skin comprising applying to the skin a composition containing an effective amount of at least one phosphosugar, which is an inherent feature of the phosphosugar containing composition of the Denis et al patent since Denis et al also discloses the application of a composition comprising a phosphosugar to skin in an amount that embraces the amount of phosphosugar used in the instant claims.

8. Claims 3, 4, 6, 9, 10, 12, 16, 17 and 19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Denis et al (US Patent No. 5,286,629) as applied to Claims 1, 2, 5, 7, 8, 11, 13, 15 and 18 above, and further in view of Ferguson (US Patent No. 5,520,926).

9. Applicant's arguments filed April 1, 2003 have been fully considered but they are not persuasive. Applicants argue against the rejection of the claims on the grounds that the Denis et al patent does not teach any therapeutic utility of a phosphosugar. Comments regarding this argument against the Denis et al patent have been dealt with in the above arguments, which are incorporated in the current argument, which concludes that the argument is not persuasive and that the rejection of the claims over the Denis et al patent is maintained for the reasons of record. In response to applicant's argument that a rejection of the claims over the Denis et al patent further in view of the Ferguson patent would only arrive at the conclusion that mannose phosphates could be used as ligands to deliver therapeutic products to the skin, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter.

1985). Applicants further argue that Ferguson indicate that mannose phosphates are not equivalent to galactose-6-phosphate and therefore one skilled in the art would not substitute the mannose phosphates of Ferguson for the galactose-6-phosphate named by Denis et al, to achieve the methods of the present invention. This argument is not persuasive since the Denis et al and Ferguson patents establish that the application of compositions comprising phosphosugars to treat damaged skin is well known in the art. Accordingly, the rejection of Claims 3, 4, 6, 9, 10, 12, 16, 17 and 19 under 35 U.S.C. 103(a) as being unpatentable over the Denis et al patent further in view of the Ferguson patent is maintained for the reasons of record.

### ***Summary***

10. All the claims are rejected.

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

### ***Examiner's Telephone Number, Fax Number, and Other Information***

12. For 24 hour access to patent application information 7 days per week, or for filing applications, please visit our website at [www.uspto.gov](http://www.uspto.gov) and click on the button "Patent Electronic Business Center" for more information.

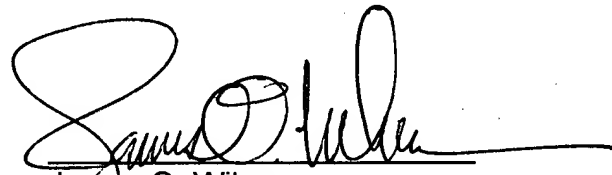
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is (703) 308-4621. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reach on (703) 308-4624. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

  
E.White

  
James O. Wilson  
Supervisory Primary Examiner  
Technology Center 1600